



Attorney Docket No. 8028

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

| | | |
|-------------------------------------------|---|----------------------------|
| In the Application of |) | Examiner Meagan S. Walling |
| Ernest A. Rodenberg, III et al. |) | Group Art Unit: 2863 |
| Application No. 10/663,313 |) | |
| Filed September 16, 2003 |) | |
| For: Programmable Electricity Consumption |) | |
| Monitoring System & Method |) | |

PETITION TO WITHDRAW FROM ISSUANCE UNDER 37 CFR §1.313(c)

Honorable Commissioner for Patents

Washington, DC 20231

Attn: Office of Petitions

Dear Sir/Madam:

Applicants petition under 37 CFR §1.313(c)(2) for withdrawal of the above-cited patent application from issuance after payment of the issue fee in favor of continued examination (RCE enclosed), so that the US Patent Examiner might consider the patents cited in the enclosed Supplemental Information Disclosure Statement. A Notice of Allowance in this pending US patent application issued, and the issue fee was mailed to the US Patent & Trademark Office on May 9, 2005. According to PAIR, the patent issue date used in the PTA calculation was September 27, 2005.

Enclosed is PTO-1449, which cites patents (also enclosed) that recently came to Applicants' attention. Also enclosed are a Petition Fee Transmittal, and a Credit Card Payment Form (PTO-2038) for the \$130.00 petition fee set forth in 37 CFR §1.17(h), and

Application No. 10/663,313

Page 2

the \$395.00 RCE fee set forth in 37 CFR §1.17(e). Also enclosed is a Request for Continued Examination under 37 CFR 1.114.

This packet (including all of the cited references) is being mailed to the US Patent & Trademark Office. It is also being faxed to the Office of Petitions in order to present it as soon as possible. Only the first pages of the cited references are being enclosed in the faxed packet, though, in order to keep it under the 50 sheet maximum for the Office fax machine. Please advise if any additional information is required.

WHEREFORE, Applicants request that the US Patent & Trademark Office withdraw the above-cited patent application from issuance in favor of continued examination (RCE enclosed), that the references cited in the enclosed Supplemental Information Disclosure Statement be considered, and that the claims be allowed.

Respectfully submitted,

The Harleston Law Firm, LLC

By: Kathleen M. Harleston
Kathleen M. Harleston
Attorney for Applicants

Mailed and faxed September 14, 2005

909 Tall Pine Road
Mt. Pleasant, SC 29464-2909
Telephone: (843)971-9453
Fax: (843)971-9505
kathleen@harlestonlawfirm.com



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FEE
Under 37 CFR 1.17(f), (g) & (h)
TRANSMITTAL
(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

| | |
|------------------------|-------------------------------------|
| Application Number | 10/663,313 |
| Filing Date | September 16, 2003 |
| First Named Inventor | Ernest Adolph Rodenberg, III, et al |
| Art Unit | 2863 |
| Examiner Name | Meagan S. Walling |
| Attorney Docket Number | 8028 |

Enclosed is a petition filed under 37 CFR 1.313(c) that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 130.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

Payment of Fees (small entity amounts are NOT available for the petition fees)

☐ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. _____:

☐ petition fee under 37 CFR 1.17(f), (g) or (h) ☐ any deficiency of fees and credit of any overpayments

Enclose a duplicative copy of this form for fee processing.

☐ Check in the amount of \$ _____ is enclosed.

☒ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

§ 1.53(e) - to accord a filing date.

§ 1.57(a) - to accord a filing date.

§ 1.182 - for decision on a question not specifically provided for.

§ 1.183 - to suspend the rules.

§ 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

§ 1.12 - for access to an assignment record.

§ 1.14 - for access to an application.

§ 1.47 - for filing by other than all the inventors or a person not the inventor.

§ 1.59 - for expungement of information.

§ 1.103(a) - to suspend action in an application.

§ 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.

§ 1.295 - for review of refusal to publish a statutory invention registration.

§ 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.

§ 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.550(c) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.

§ 1.956 - for patent owner requests for extension of time in *inter partes* reexamination proceedings.

§ 5.12 - for expedited handling of a foreign filing license.

§ 5.15 - for changing the scope of a license.

§ 5.25 - for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

§ 1.19(g) - to request documents in a form other than that provided in this part.

§ 1.84 - for accepting color drawings or photographs.

§ 1.91 - for entry of a model or exhibit.

§ 1.102(d) - to make an application special.

§ 1.138(c) - to expressly abandon an application to avoid publication.

§ 1.313 - to withdraw an application from issue.

§ 1.314 - to defer issuance of a patent.


Signature

Kathleen M. Harleston

Typed or printed name

September 14, 2005

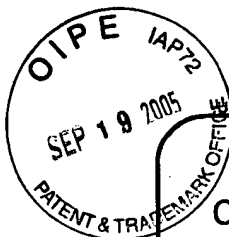
Date

33,398

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



**Request
for
Continued Examination (RCE)
Transmittal**

Address to:
Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

| | |
|------------------------|--------------------------------------|
| Application Number | 10/663,313 |
| Filing Date | September 16, 2003 |
| First Named Inventor | Ernest Adolph Rodenberg, III, et al. |
| Art Unit | 2863 |
| Examiner Name | Meagan S. Walling |
| Attorney Docket Number | 8028 |

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____

ii. ☐ Other _____

b. ☒ Enclosed

i. ☐ Amendment/Reply

iii. ☒ Information Disclosure Statement (IDS)

ii. ☐ Affidavit(s)/ Declaration(s)

iv. ☐ Other _____

2. **Miscellaneous**

a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

b. ☐ Other _____

3. **Fees**

The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

The Director is hereby authorized to charge the following fees, or credit any overpayments, to

a. ☐ Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.

i. ☐ RCE fee required under 37 CFR 1.17(e)

ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)

iii. ☐ Other _____

b. ☐ Check in the amount of \$ _____ enclosed

c. ☒ Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

| | | | |
|-------------------|------------------------------|------------------|--------------------|
| Signature | <i>Kathleen M. Harleston</i> | Date | September 14, 2005 |
| Name (Print/Type) | Kathleen M. Harleston | Registration No. | 33,398 |

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

| | | | |
|-------------------|------------------------------|------|--------------------|
| Signature | <i>Kathleen M. Harleston</i> | Date | September 14, 2005 |
| Name (Print/Type) | Kathleen M. Harleston | | |

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



RCE *[initials]*

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| | | | |
|-----------------------------------------------------------------------------------------|----------------------|-------------------------------------|------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/663,313 | |
| | Filing Date | September 16, 2003 | |
| | First Named Inventor | Ernest Adolph Rodenberg, III, et al | |
| | Art Unit | 2863 | |
| | Examiner Name | Meagan S. Walling | |
| Total Number of Pages in This Submission | 324 | Attorney Docket Number | 8028 |

| ENCLOSURES (Check all that apply) | | |
|---------------------------------------------------------------------------|---------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| <input checked="" type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to TC |
| <input checked="" type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input type="checkbox"/> Amendment/Reply | <input type="checkbox"/> Petition | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Change of Correspondence Address | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Terminal Disclaimer | RCE |
| <input checked="" type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> Request for Refund | Petition under 37 CFR 1.313(c) |
| X Copies attached | <input type="checkbox"/> CD, Number of CD(s) _____ | Credit Card Payment Form |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> Landscape Table on CD | |
| <input type="checkbox"/> Reply to Missing Parts/Incomplete Application | Remarks | |
| <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | | |
|--------------------------------------------|------------------------------|----------|--------|
| Firm Name | The Harleston Law Firm, LLC | | |
| Signature | <i>Kathleen M. Harleston</i> | | |
| Printed name | Kathleen M. Harleston | | |
| Date | September 14, 2005 | Reg. No. | 33,398 |

| CERTIFICATE OF TRANSMISSION/MAILING | | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|------------------------------|------|--------------------|
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: | | | |
| Signature | <i>Kathleen M. Harleston</i> | | |
| Typed or printed name | Kathleen M. Harleston | Date | September 14, 2005 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.